

ESTTA Tracking number: **ESTTA678268**

Filing date: **06/15/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92058047
Party	Plaintiff 2156775 Ontario Inc.
Correspondence Address	RONALD E SHAPIRO SHAPIRO AND SILVERSTEIN PLLC 11350 RANDOM HILLS ROAD, SUITE 740 FAIRFAX, VA 22030 UNITED STATES rshapiro@sasiplaw.com
Submission	Other Motions/Papers
Filer's Name	Ronald E. Shapiro
Filer's e-mail	rshapiro@sasiplaw.com
Signature	/Ronald E. Shapiro/
Date	06/15/2015
Attachments	Petitioner's Motion for Modification of Decision.pdf(656060 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

2156775 ONTARIO INC.,

Petitioner,

v.

GI GROUP, INC.,

Respondent.

Cancellation No. 92058047

Registration No. 3,624,412

Mark: STARZ

**PETITIONER'S MOTION FOR MODIFICATION OF DECISION
AND MEMORANDUM IN SUPPORT THEREOF**

Pursuant to 37 CFR § 2.129(c), Petitioner, 2156775 Ontario Inc., hereby moves that the Trademark Trial and Appeal Board modify its decision of May 15, 2015, to specify that the dismissal of the petition is without prejudice. The basis for this motion is set forth in the Memorandum below, which is incorporated by reference herein.

MEMORANDUM

In its decision dated May 15, 2015, the Trademark Trial and Appeal Board held that Petitioner had failed to prove standing, and dismissed the petition, with prejudice, on that basis alone. As Petitioner's failure to prove standing was the sole ground for dismissal, Petitioner respectfully submits that the dismissal should be without prejudice.

The Court of Appeals for the Federal Circuit has repeatedly emphasized that a dismissal for lack of standing should be without prejudice, particularly when, as in the present case, the

defect is curable. See *University of Pittsburgh v. Varian Medical Systems, Inc.*, 569 F.3d 1328, 1333 (Fed. Cir. 2009) (“the law universally disfavors dismissing an action with prejudice based on lack of standing, and there is a strong presumption that such a dismissal is improper.”); *Tyco Healthcare Group Lp v. Ethicon Endo-Surgery*, 587 F.3d 1375 1380 (Fed. Cir. 2009); *Fieldturf, Inc. v. Sw. Recreational Indus.*, 357 F.3d 1266, 1269 (Fed. Cir. 2004) (“Ordinarily, dismissal for lack of standing is without prejudice.”); *H.R. Techs., Inc. v. Astechnologies, Inc.*, 275 F.3d 1378, 1384 (Fed. Cir. 2002) (“Because lack of standing is not an issue that goes to the merits of the underlying ... issues, a dismissal of a complaint for lack of standing would not normally be expected to be made with prejudice.”).

As the dismissal of the petition with prejudice is contrary to longstanding Federal Circuit precedent, Petitioner respectfully submits that the Board’s decision should be modified to specify that the dismissal is without prejudice.

Respectfully submitted,

Date: June 15, 2015




Ronald E. Shapiro
Shapiro and Silverstein PLLC
11350 Random Hills Road, Suite 740
Fairfax, Virginia 22030
Tel: 703-273-7680
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing document was mailed to Respondent's attorney of record on June 15, 2015, by first class mail, postage prepaid, at the following address:

John A. James, Esq.
Law Offices of John A. James
439 S Buena Vista Street
Redlands, CA 92373



Ronald E. Shapiro